



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/380,638 09/07/99 IMANISHI T IMANISHI=2

001444 HM12/0822  
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EXAMINER

CRANE, L

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

08/22/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/380,638

Applicant(s)

Imanishi et al.

Examiner

L. E. Crane

Group Art Unit

1623

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on application date (371 papers)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other See Rules Compliance Report

Office Action Summary

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1623.

5        The application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. §1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §1.821 through §1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent  
10       Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is given 3 (THREE) MONTHS from the date of this letter within which to comply with the sequence rules, 37 C.F.R. §1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of  
15       the application under 37 C.F.R. §1.821(g). Extension of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. §1.136. In no case may an applicant extend the period for response beyond the SIX MONTH statutory period. Applicant is requested to return a copy of the attached Notice To Comply with the  
20       response.

No claims have been cancelled and no preliminary amendments filed as of the date of the instant Office action.

Claims 1-5 remain in the case.

25       Claims 1 and 3-5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

5 In claim 1, line 5, the term "or an analogue thereof" is lacking in properly defined metes and bounds, thereby rendering the instant claim indefinite for failure to particularly point out and distinctly claim the subject matter. The same problem reoccurs in claim 4 at line 6 and in claim 5 at line 7.

10 In claim 1, lines 7-9, the individual included terms within the term "alkyl group, ... or a silyl group" each lack an upper bound and therefore render the instant claim indefinite for failure to particularly point out and distinctly claim the subject matter. A similar problem reoccurs in claim 5 at line 8 ("alkoxy group") and at lines 10-16.

15 ✓ In claim 1, line 7, the term "alkynyl" is not an IUPAC recognized name. Appropriate amendment of the claim and parallel correction of the specification will require a showing that the suggested substitute (-- alkynyl --?) corresponds with the noted term.

20 In claim 1, last line, the term "or an amidite derivative thereof" is lacking in properly defined metes and bounds, thereby rendering the instant claim indefinite for failure to particularly point out and distinctly claim the subject matter.

✓ In claim 3, line 3, the term "phosphino" appears to be technically incorrect. Did applicant intend the term to read -- phosphityl --?

✓ In claim 5, at lines 16 and 18-19, the terms "n<sup>1</sup>.s" and "n<sup>2</sup>.s" appear to include grammatical errors (misplaced commas).

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

5 (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."

10 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

(f) he did not himself invent the subject matter sought to be patented."

Claims 1-2 are rejected under 35 U.S.C. §102(a) and (f) as being anticipated by Obika et al. (PTO-892 ref. R).

15 The subject matter of the noted reference anticipates the instant noted claims, but lists an inventive entity which differs from the instant inventive entity.

Claims 3-5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112 set forth in this Office Action.

20 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not  
25 commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

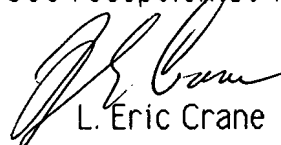
5 Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are (703) 308-4556 and 703-305-3592 .

10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is 703-308-4639 . The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

15 Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235 .

LECrane:lec  
**08/11/00**

  
L. Eric Crane  
Patent Examiner  
Group 1600